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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,281	06/20/2003	Peter Strarup Jensen	SUNMP155	6348

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EXAMINER

NGUYEN, DUSTIN

ART UNIT PAPER NUMBER

2154

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/600,281

Applicant(s)

JENSEN ET AL.

Examiner

Dustin Nguyen

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/05/2006</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1 – 20 are presented for examination.

#### ***Specification***

2. Examiner requests Applicants to update status of related application as mentioned in paragraph 0001 of the disclosure.

#### ***Claim Objections***

3. Claims 1-20 are objected to because of the following informalities:
  - I. As per claims 1, 9 and 17, please replace “.” with “;” after “...installed on the client device”.
  - II. As per claims 2-8, please replace “A computer” with “The computer” on line 1.
  - III. As per claims 10-16, please replace “A method” with “The method” on line 1.
  - IV. As per claims 18-20, please replace “A system” with “The system” on line 1.
  - V. As per claim 6, please correct the following error, “that allows that allows”.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

Art Unit: 2154

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "A computer protocol" is being considered as nonstatutory functional descriptive material.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

- 1) In the claim, the practical application of an algorithm or idea result in a useful, concrete, tangible result, AND
- 2) The claim provides a limitation in the technological art that enables a useful, concrete, tangible result.

As to the technology requirement, note MPEP Section iV 2(b). Also note In Re Waldbaum, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In re Musgrave, 167USPQ 280 (CCPA1970), In re Johnston, 183USPQ 172 (CCPA 1974), and In re Toma, 197USPQ 852 (CCPA 1978), all teach a technological requirements.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

Art Unit: 2154

patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Mehta et al. [ US Patent Application No 2002/0131404 ].

7. As per claim 1, Mehta discloses the invention as claimed including a computer protocol for provisioning services [ i.e. methods and systems for maintaining and provisioning wireless applications ] [ Figure 1; Abstract; paragraphs 0005 and 0012 ], comprising:

discovery transactions that allow a client device to retrieve information regarding services available to the client device from a provisioning server [ i.e. the MAS to retrieve a list of available applications that can be downloaded to the subscriber's device, this is referred to application discovery ] [ Figure 4; and paragraphs 0006, 0067 and 0070 ], wherein a service comprises a plurality of content files capable of being installed on the client device [ i.e. installation or uninstallation of applications on the wireless device ] [ paragraphs 0063 and 0064 ].

subscription transactions that allow the client device to manage content in service directories [ i.e. a Personalization Website, which is used by subscribers to order, ... and to manage applications ] [ paragraphs 0091, 0115 and 0116 ], wherein a service directory comprises a plurality of services [ paragraphs 0091, 0131 ]; and

delivery transactions that allow the client device to download data related to services [ i.e. the Deployment Manager prepares applications for delivery to a subscriber device ] [ Figure 7; and paragraphs 0075 and 0076 ].

8. As per claim 2, Mehta discloses wherein the discovery transactions includes a service discovery transaction that allows the client device to obtain information regarding a particular service [ i.e. application discovery returns a list of content that can be downloaded that match criteria ] [ Figure 4; and paragraphs 0006 and 0067 ].

9. As per claim 3, Mehta discloses wherein the discovery transactions include a service directory discovery transaction that allows the client device to obtain information regarding a particular service directory [ i.e. A subscriber's Personal Access List is the list of applications that the subscriber desires to have the MAS display during application discovery ] [ paragraphs 0016, 0019 and 0020 ].

10. As per claim 4, Mehta discloses wherein the subscription transactions include a service subscription transaction that allows a service to be added to a service directory [ i.e. adding applications ] [ Figures 11E-H; paragraphs 0116 and 0117 ].

11. As per claim 5, Mehta discloses wherein the subscription transactions include an unsubscribe transaction that allows a service to be removed from a service directory [ i.e. removing applications ] [ Figure 11J; and paragraphs 0116 and 0118 ].

12. As per claim 6, Mehta discloses wherein the delivery transactions include an update transaction that allows that allows the client device to obtain a provisioning update comprising a

Art Unit: 2154

list of services that should be installed on the client device [ i.e. a list of new applications that can be potentially downloaded ] [ paragraph 0063 ].

13. As per claim 7, Mehta discloses wherein the delivery transactions include a notification transaction that allows the provisioning server to request the client device to perform an update transaction [ i.e. a notification that an updated version is available ] [ paragraphs 0063 and 0110 ].

14. As per claim 8, Mehta discloses wherein the delivery transactions include a delivery transaction that allows the client device to download data related to a service [ i.e. send the packaged application to the requesting subscriber device ] [ 310, Figure 3; and paragraphs 0070 and 0131 ].

15. As per claims 9-16, they are method claimed of claims 1-8, they are rejected for similar reasons as stated above in claims 1-8.

16. As per claims 17-20, they are apparatus claimed of claims 1-8, they are rejected for similar reasons as stated above in claims 1-8.

17. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for

Art Unit: 2154

response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

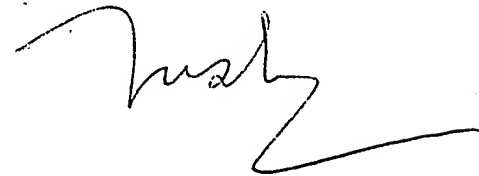
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached at (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen

Examiner

Art Unit 2154

A handwritten signature in black ink, appearing to read 'Dustin', with a long horizontal flourish extending to the right.